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4000

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 759,353	01 16 2001	Jean Pierre Challet	025200-038	2141

21839 7590 03 25 2002

BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 03 25 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

C9/759,353

Applicant's

CHALLET

Examiner

KENT L BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to ~~communication(s) filed on~~ application filed 1/16/01
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO 892)
- 16) ☐ Interview Summary (PTO 413) Paper No. \_\_\_\_\_
- 17) ☒ Notice of Applicant's Patent Drawing Review (PTO 946)
- 18) ☐ Notice of Informal Patent Application (PTO 152)
- 19) ☐ Information Disclosure Statement(s) (PTO 1449) Paper No. \_\_\_\_\_
- 20) ☒ Other Rule 1.105 Requirement

**Detailed Action**

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(c) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before the "Summary of the Invention" section as set forth in 37 CFR 1.163(c).

B. Page 3, lines 8 and 9 and page 6, lines 1-7. It is noted that the only distinguishing feature set forth between the instant cultivar and its parent is bloom coloration. Applicant should provide additional information which distinguishes the two plants from each other. Such could be accomplished by performing a systematic side by side comparison between the two plants in

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which applicant could obtain additional distinguishing information such as response time, bloom size, leaf size, etc.

C. A detailed search of the parent cultivar, 'Chadixi', was performed and little information was found. Applicant should state for the record if this cultivar was commercially available and if so set forth the first day of sale in the United States.

D. Page 5, lines 2 and 3 should be deleted as this information should be placed at the beginning of the specification as set forth in "A" above.

E. Applicant should set forth in the specification the typical and observed flowering response time, i.e. how long it takes the plants to flower after planting.

F. Applicant should set forth in the specification the typical and observed number of inflorescences per plant.

G. Applicant should set forth in the specification information relative to the instant plant's peduncles including the typical and observed length, diameter, and coloration. Color designation(s) should be referenced by the employed color chart.

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H. Page 5, lines 8-10. Applicant should set forth in the specification additional information relative to the instant plant's inflorescence including the typical and observed depth.

I. Page 5, line 11. Applicant should set forth in the specification additional information relative to the instant plant's buds including the typical and observed shape, length, and diameter.

J. Page 5, line 12. Applicant recites "Corolla florets". This recitation is not understood as chrysanthemums typically have Ray florets or Ray florets and Disc florets. It appears applicant may have meant to state "Ray florets". Correction and/or clarification is necessary.

K. Page 5, line 12 to page 6, line 8. Applicant should set forth in the specification additional information relative to the instant plant's ray florets including the typical and observed number per inflorescence, shape, length, width, apex, base, and margin descriptors in the interest of providing as complete a description of the plant as is reasonably possible.

L. Page 5, line 13. Applicant states "Outer Side". Rather than stating "Outer Side", applicant should state either "Upper surface" or "Under surface". Whichever term is accurate. Correction is necessary.

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M. Page 5, lines 15 and 16. Applicant states "light red". Applicant should set forth in the specification the RHS designation for the "light red" coloration. The recitation "light red" is insufficient in this regard.

N. Page 5, line 17. Applicant states "Inner Side". Rather than stating "Inner Side", applicant should state either "Upper surface" or "Under surface". Whichever term is accurate. Correction is necessary.

O. Page 6, line 1. Applicant states "florete". However applicant does not specify whether it is the ray florets or disc florets which is being compared. Correction and/or clarification is necessary.

P. Page 6, line 8. Applicant recites "Configuration ray florets. - Petaloid.". This recitation is not understood as it does not make any sense. It is not understood as ray florets are not petaloid. Ray florets are usually configured/arranged acropetally on a capitulum.

Q. Applicant should set forth in the specification information relative to the instant plant's phyllaries including the typical and observed number per inflorescence, shape, length, width, apex and margin descriptors, and coloration with reference to the employed color chart.

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R. Page 6, line 11. Applicant states the Androecium is present on ray florets. This is not understood and appears botanically incorrect as the androecium is typically found only on disc florets and the gynoecium is typically found on both ray and disc florets. This plant does not have disc florets as set forth on line 9 of the same page. Correction and/or clarification is necessary.

S. Page 6, lines 13-16. Applicant states the instant plant produces pollen. This is not understood and appears botanically incorrect as the instant plant does not have disc florets (as stated on line 9 of the same page) and without disc florets, in which the androecium would be located, cannot produce pollen. Correction and/or clarification is necessary.

T. Page 7, line 10 to page 8, line 17. Applicant should set forth in the specification additional information relative to the instant plant's leaves including the typical and observed shape.

U. Page 8, line 13. Applicant states the leaf thickness is "Medium". Applicant should set forth in the specification a measurement for "Medium". The recitation "Medium" is vague and insufficient in this regard.



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V. Applicant has not set forth whether the instant plant's leaves are petiolate or sessile. If the leaves are petiolate, applicant should set forth in the specification the typical and observed petiole length, diameter, and coloration with reference to the employed color chart. If the leaves are sessile, applicant should simply state in the specification that the leaves are sessile.

W. Applicant should set forth in the specification information relative to the instant plant's resistance/susceptibility to disease and pests.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

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**Potential Issue Under 35 U.S.C. 102**

The claimed Chrysanthemum variety 'Chanoud' is described in Breeder's Right application number 15135 filed in France on November 7, 1996 and published on November 10, 1996. The claimed Chrysanthemum is also described in Breeder's Right application number 15/5031 filed in Great Britain. However, the actual date for application and publication date, if any, is unknown. The published French application is a "printed publication" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the documents relate. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the French application (15135) is obtainable through the Bulletin Officiel de la Protection des Obtentions Vegetales, which is available to the public. Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)("The issue is not whether the [claimed] cultivar Siokra

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was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the reference(s) is enabling. If the plant was publicly available, then the application(s), combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office’s collection of retail catalogs has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office’s collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

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**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT L. BELL  
PATENT EXAMINER**

*Kent L. Bell*

**Detailed Action**

**REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Chanoud', was publicly available prior to the filing date of the instant application

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published French application 15135 and Great Britain application 15/5031 (if published). The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. Since the inventor of the instant application is listed by UPOV as the breeder of the published application, it is reasonable to expect that Applicant can readily obtain the requested document(s) and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first

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communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.